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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,395	06/23/2003	James Bradley Enlow	32942	8024

7590

12/17/2004

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EXAMINER
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BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/601,395

Applicant(s)

ENLOW, JAMES BRADLEY

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. The changes to claim 12 is agreed with and the objection is removed.

### ***Claim Rejections - 35 USC § 112***

2. The changes to the claims are agreed with and the rejections under 35 U.S.C. 112, second paragraph, are removed.

### ***Double Patenting***

3. Canceling claims 8, 10, 19, and 21 are agreed with and the possible objection to under 37 CFR 1.75 is removed.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over 4,736,950 in view of 2001-46568 and Manual.

4,736,950 discloses a golf club (Col. 1, Ln. 31), a grip having a length from about 4-14 inches (Fig. 5A, equation (7)), a small outboard end D1 as compared to D3 (Figs. 5A and 5B), and an outer surface presenting a reverse taper surface section in the form of L2 between an outboard and inboard ends (Fig. 5A), an elongated region of substantially constant diameter extending from a reversed taper section towards an inboard end (L3), L3 having a length of 1-4 inches (Fig. 5A, equation 7), and a ratio of reverse taper section L2 to a constant taper section L3 being  $8/3$  (Equation 4). Doyle does not disclose a ratio of reverse taper section L2 to a constant taper section L3 being 4-7 but clearly Doyle discloses a grip to be used with a golf club and a golf club grip requires a much longer grip to receive two hands than a racket as shown in Fig. 5C. In order to maintain the inventive concept of thumb and index finger placement for a golf club it would be obvious that section L2 would only be extended. An artisan making grip as shown in figure 5C for a golf club would have selected a suitable section L2 that was extending in which a ratio of a length of a reverse taper section to a length of a constant diameter section being from about 4-7 is included.

4,736,950 lacks an axial bore, a body thickness between an outer and inner surfaces, a body thickness increasing along the length of the reverse taper surface section from a smaller thickness nearer an outboard end to a greater thickness nearer an inboard end, a head with a shaft extending from, a free end of a shaft remote from a head, a ratio of greater thickness to a smaller thickness being from 1.1 to 1.7, a grip

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being a resilient synthetic resin material, a ratio of a length of a reverse taper section to a length of a constant diameter section being from about 4-7, a grip density from about 2.8 to 3.5 lbs/ft<sup>3</sup>, and a grip material having an indentation force deflection from 30-85lbs..

2001-46568 discloses a grip having a substantially cylindrical shaft with the outer surface of a grip changing due to the thickness of the grip changing (Fig. 2), a grip having an axial bore, a head with a shaft extending from, a free end of a shaft remote from a head, and an outer surface presenting a reverse taper surface section between an outboard and inboard ends with a body thickness increasing along the length of the section from a smaller thickness nearer an outboard end to a greater thickness nearer an inboard end (Figs. 2, 4B). 2001-46568 does not disclose the exact ratio of greater thickness to a smaller thickness but shows different degrees of outer surface tapering from cylindrical to a significant taper (Figs. 5c, 5d, 6a, 6b, 6c) and a shaft substantially cylindrical (Fig. 2). In view of the reference of 2001-46568 it would have been obvious to modify the club of 4,736,950 to have an axial bore throughout the length of the grip with the outer shape of the grip being formed by both a change in thickness of a grip and an outer shaft shape in order to utilize both the thickness of a grip and a shaft shape in forming a grip fitting over a shaft. As such it would be obvious to have a body thickness increasing along the length of the reverse taper surface section from a smaller thickness nearer an outboard end to a greater thickness nearer an inboard end. In view of the reference of 2001-46568 it would have been obvious to modify the club of 4,736,950 to have a ratio of greater thickness to a smaller thickness being from 1.3 to

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1.5 in order to provide sufficient support and vibration absorption to a golfer. In view of the reference of 2001-46568 it would have been obvious to modify the club of 4,736,950 to have a head with a shaft extending from and a free end of a shaft remote from a head in order to maximize the velocity of a head at impact.

Manual discloses a grip having a resilient synthetic resin material comprising a polyurethane foam (Col. 4, Lns. 28-45) and an EVA resin having a density of .12-.3 grams/cm<sup>3</sup> and a hardness of 40-70 in the ASTM D2240C (Col. 5, Lns. 3-18) in order to have a light weight grip, material which absorbs shock, and firm support (Col. 3, Lns. 10-27). Manual does not disclose the density or indentation force deflection value of the polyurethane foam but clearly an artisan skilled in the art to form a light weight grip with a sufficient rigidity would have selected a suitable density and indentation force deflection in which a grip density from about 2.8 to 3.5 lbs/ft<sup>3</sup> and a grip material having an indentation force deflection from 30-85lbs are included. In view of the patent of Manual it would have been obvious to modify the grip of 2001-46568 to be made of a polyurethane foam in order to have a light weight grip, material which absorbs shock, and firm support. In view of the patent of Manual it would have been obvious to modify the grip of 2001-46568 to have a grip density from about 2.8 to 3.4 lbs/ft<sup>3</sup> and a grip material having an indentation force deflection from 30-80lbs in order to have a sufficiently rigid grip for a golfer who prefers more support.

It would have been obvious to modify the grip of 4,736,950 to a ratio of a length of a reverse taper section to a length of a constant diameter section being from about 4-7 in order to provide a grip for a golf club which requires both hands to grip a club.

***Response to Arguments***

6. The argument that the reference of '950 grip would be incapable of receiving a shaft is disagreed with. Nothing in the claims requires a shaft to have a specific outer shape profile and they're are shafts known which decrease in diameter approaching a butt end. Also grips having a bore with a shaft inserted is the most common type of grip used in the art. The argument that the Japanese reference does not suggest a constant diameter inboard section is agreed with. However the Japanese references was not used for this teaching but Doyle was (L3).

***Allowable Subject Matter***

7. The examiner recommends the following amendment to claim 1 to make the claims overcome the reference of Doyle.

a. In claim 1 line 12 the word "region" has been replaced by the word -- section --.

b. In claim 1 line 15 after the words "from about 4-7" the words -- wherein said grip includes only two sections of substantial length those being said constant diameter section and said reverse section -- have been added.

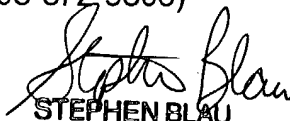
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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**